

Remarks

The undersigned's Remarks are preceded by related comments of the Examiner, presented in small bold-faced type.

Claims 6, 7, 12, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article "Eastman Chemical Company..." (Press Release, March 17, 2000) in view of the software package "BlendPro" taught in the article "Solvents - continuing to evolve for the future" (Beers et al. 1998, Pigment and Resin).

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It would have been obvious to one skilled in the art at the time to modify e-commerce enabled formulators, as disclosed in "Eastman", to provide customers with a product selection tool that aids them - the customers - in creating a custom chemical composition from a starting point using their desired specifications, as taught by BlendPro., in order to avoid a lengthy and inaccurate development process and further to aid the customer in efficiently keeping up with changing technical requirements. [Please note the reference to commercial activity in Beers et al. - Page 5, where production of a re-formulated material is made within the context of "lowest cost"].

The Examiner's rejection of claims 6, 7, 12, 20, and 21 is respectfully traversed. To the extent that elements of the claimed invention are disclosed in the March 17, 2000, Eastman Chemical Company press release ("Eastman") and in "BlendPro," the Examiner's combination of these elements appears to be nothing more than a hindsight combination of these references taught by the applicant's disclosure. Rejection under 35 U.S.C. § 103(a) requires more.

To sustain a rejection under 35 U.S.C. § 103(a), the Examiner must also show that there exists some teaching or knowledge in the art to combine the cited prior art references so as to obtain the invention claimed by the applicant. Merely citing that "it would have been obvious to one skilled in the art" is not enough. As stated in MPEP § 2141.01, the basic considerations which apply to obviousness rejections include the following:

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

(A) The claimed invention must be considered as a whole;

(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

(C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

(D) Reasonable expectation of success is the standard with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

(MPEP § 2141.01 citing to *Hodosh v. Block Drug Co.* (emphasis added))

The Examiner has failed to meet this standard. For example, element (b) requires that “the references . . . suggest the desirability and thus the obviousness of making the combination.” The Examiner, in her comments, suggests that the desirability of combining Eastman’s business-to-business commerce system with the BlendPro formulation software is “to avoid a lengthy and inaccurate development process and further to aid the customer in efficiently keeping up with changing technical requirements.” The undersigned has reviewed these references and, contrary to requirement (B), quoted above, this suggestion to combine is NOT found in the references. Accordingly, the Examiner has not adhered to the “tenet of patent law” requiring that “The references . . . must suggest the desirability and thus the obviousness of making the combination;” (MPEP § 2141.01 citing to *Hodosh*) (emphasis added).

Furthermore, the “tenets of patent law” also require that “(C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.” Because the Examiner’s explanation of the “desirability . . . of making the combination” (i.e., “to avoid a lengthy and inaccurate development process and further to aid the customer in efficiently keeping up with changing technical requirements.”) is not found within the references, then, without objective evidence to the contrary, one must conclude that the explained “desirability . . . of making the combination” could have only come from the applicant’s disclosure. This is not the proper basis for a rejection of claims. Id.

The Examiner’s rejection of claims 6, 7, 12, 20, and 21 depends upon a combination of the Eastman and BlendPro references that is contrary to the mandatory “tenets of patent law” set forth in MPEP § 2141.01. For at least the foregoing reasons, the Examiner’s rejection of claim 6, 7, 12, 20, and 21 under 35 U.S.C. § 103(a) is improper. Applicant respectfully request that the rejection be withdrawn.

Furthermore, even if a teaching to combine Eastman and BlendPro were to be found, the combination of Eastman and BlendPro would still not disclose each and every element of the rejected claims and, accordingly, would not sustain a rejection under 35 U.S.C. § 103(a). That is, neither Eastman or BlendPro, alone or in combination, disclose a networked system configured for commerce in chemical products that can: receive a request comprising a product identifier from a first one of the plurality of client computers, query a database in response to the received request to retrieve chemical product data comprising a starting point formulation and chemical characteristics inherent to the starting point formulation, send the chemical product data to the first client computer, receive a purchase order comprising a request to purchase a product identified by the product identifier and target characteristics input by a user, modify the starting point formulation based on the target characteristics input by the user, and process the purchase order, wherein the purchase order comprises an order for purchase of a chemical product formulated in accordance with said modified starting point formulation. What Eastman is understood as teaching is a more "traditional" e-commerce system in which products having predetermined characteristics are sold. What BlendPro is understood as teaching is a system for formulating products that is used before the products are offered to customers making a purchase. Neither Eastman nor BlendPro teach or suggest a system in which the customer himself or herself is actively involved in the reformulation process. Accordingly, rejection under 35 U.S.C. § 103(a) is improper because the cited references do not teach or suggest all elements of the recited claim when the "claimed invention [is] considered as a whole" as required by MPEP 2141.01.

For at least these additional reasons, claims 6, 7, 12, 20, and 21 are patentable over the cited prior art and the rejection of these claims under 35 U.S.C. § 103(a) in light of the cited art should not be maintained. The undersigned respectfully request that the rejection be withdrawn.

Claims 9, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article "Eastman Chemical Company..." (Press Release. March 17, 2000) in view of the software package "BlendPro" taught in the article "Solvents - continuing to evolve for the future" (Beers et al. 1998. Pigment and Resin), as applied in claims 6 and 20, in further view of the service provided by WorldWideTesting.com as discussed in the article "World WideTesting.com...the Missing Link" (Press Release. June 22, 1999).

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Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article "Eastman Chemical Company..." (Press Release. March 17, 2000) in view of the software package "BlendPro" taught in the article "Solvents - continuing to evolve for the future" (Beers et al. 1998. Pigment and Resin), in further view of the service provided by World WideTesting.com as discussed in the articles "World WideTesting.com...the Missing Link" (Press Release. June 22, 1999), as applied in claim 9, in further view of official notice regarding e-commerce.

The Examiner's rejections of claims 9, 10, 11, and 22 each depend on an improper combination of Eastman and BlendPro and, accordingly, are traversed for at least the same reasons stated with respect to claims 6, 7, 12, 20, and 21. The undersigned requests that these rejections also be withdrawn.

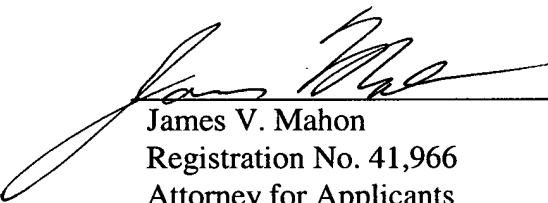
Conclusions

Claims 6, 7, 9-12, 20-22 are now pending and believed to be in condition for allowance. Applicant respectfully requests that all pending claims be allowed.

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Respectfully submitted,

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